

Appl. No. 10/665,539  
Amendment dated December 16, 2004  
Reply to Office Action of September 22, 2004

### **REMARKS/ARGUMENT**

This Amendment is submitted in response to the Office Action mailed September 22, 2004, which was non-final. In the September 22, 2004 Office Action, the Examiner rejected claims 1-3, 9 and 10 under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,816,961 (*Kraemer*), and claims 1-10 under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 6,113,508 (*Locarno*).

This application was filed with a total of ten claims. Of these, only claim 1 is presented in independent form. Claims 2-10 are severally dependent, either directly or indirectly, on claim 1. Applicants respectfully request reconsideration of the stated grounds for rejection in the light of the following argument.

#### **Amendment**

The specification discloses a hand shield used to protect a player's hand when inserted therein (Application, p. 1, lines 25-26; p. 3, lines 27-28; p. 5, lines 1-6). Neither *Kraemer* nor *Locarno* discloses a device or apparatus used to shield a hand. In addition, neither reference discloses a "hand shield" as that term is ordinarily understood. The dictionary definition of shield, for example, includes "[a] person or thing that provides protection." *The American Heritage Dictionary* (4th ed. 2000).

Applicants have amended independent claim 1 to clarify that the hand shield of Applicants' invention includes a substantially concave inner surface which is configured to shield all or part of a player's hand.

Neither *Kraemer* nor *Locarno* discloses a hand shield with a concave inner surface which is configured to shield all or part of a user's hand. *Kraemer* discloses a bell shaped housing (26) having a convex outer surface. The housing in *Kraemer* is not configured to shield or protect a hand, but to permit rotation of a hockey stick shaft to orient its blade relative to a playing surface. In addition, the bell shaped housing and the inner surface of that housing do not shield, protect or envelop a user's hand. In fact, it would not be possible to insert a hand into the bell shaped housing of *Kraemer* during use.

Likewise, the cap in *Locarno* is not configured to shield a hand, but to allow for control or manipulation of a hockey stick. The inner surface of the cap in *Locarno* cannot shield all or part of a player's hand. A hand may not be inserted into the cap for protection.

As a result, Applicants urge that amended claim 1 distinguishes patentably from the prior art. Further, because claims 2–10 are severally dependent, either directly or indirectly, on independent claim 1, claims 2–10 are to be construed as incorporating by reference all of the limitations of that main claim. Hence, if independent claim 1 distinguishes patentably from the prior art, then each of the dependent claims 2–10 must similarly so distinguish. Accordingly, claims 1–10 are believed to be in condition for allowance.

Additional Remarks/Argument - *Kraemer*

There is no disclosure or suggestion in *Kraemer* that the bell shaped housing is “flexible” as in claim 1 of the application. Thus, Applicants respectfully submit that the claims as originally presented distinguish from *Kraemer*.

Appl. No. 10/665,539  
Amendment dated December 16, 2004  
Reply to Office Action of September 22, 2004

In addition, it is respectfully submitted that the “internal splines” (48) in *Kraemer* are not “configured so as to slidably embrace” a hockey stick, as in claim 1 of the application. In fact, it is not clear in Figs. 5 and 6 whether the internal splines are attached or connected in any manner to any portion of a hockey stick. This aspect of claim 1 also distinguishes from *Kraemer*.

The Examiner also states that *Kraemer* discloses an opening in the outer surface of the bell housing which is “configured to accommodate a portion of a hockey stick that may be passed therethrough” as Applicants have claimed in claim 1. However, neither Fig. 2 nor Fig. 3 nor Fig. 6 in *Kraemer* illustrate any portion of a hockey stick passing through the outer surface of the housing. To the contrary, Fig. 3 illustrates a portion of a hockey stock (52) which is larger in diameter than the adjacent bell shaped housing (38). It does appear that a “rod” (44) passes through the bell shaped housing, but not a hockey stick. This aspect of claim 1 also distinguishes from *Kraemer*.

With respect to claim 3, Applicants respectfully submit that Fig. 6 of *Kraemer* does not disclose “flexible tabs” as in the application. Nothing in the reference suggests that the splines (48) in Fig. 6 are flexible; rather, they appear to be rigid.

For these reasons also, Applicants urge that independent claim 1 and dependent claims 2, 3, 9 and 10 distinguish patentably from the prior art.

Additional Remarks/Argument - *Locarno*

The Examiner states that “the broadest reasonable interpretation of shield portion would include” the cap (18) or butt end in *Locarno*. However, it is respectfully submitted that the

Appl. No. 10/665,539  
Amendment dated December 16, 2004  
Reply to Office Action of September 22, 2004

application makes clear that the claimed shield portion does not include a butt end. In claim 7 of the application, and in the specification (p. 2, lines 1-3 and 20-22), Applicants claim and describe their hand shield as being adapted for use with hockey stick *having a fixed butt end*. As claim 7 depends from claim 1, it must be construed as incorporating by reference the limitations of that main claim. Accordingly, the “flexible shield portion” in Applicants’ invention cannot be interpreted as equivalent to a “butt end” as disclosed in *Locarno* (18). It is clear that Applicants’ definition of “shield portion” does not encompass a “butt end,” which Applicant’s describe as something quite different.

In addition, the Examiner asserts that the “interior grip portion” of claim 1 of the application reads on the “rubber sheath” (36) in *Locarno*. However, the rubber sheath cannot be “connected to” the cap in *Locarno* as required by claim 1 (“an interior grip portion connected to said shield portion”); rather, the rubber sheath is simply the upper portion of the cap. For the same reason, it also cannot be said that the sheath “extends away” from the cap or shield portion, as in claim 1 of the application.

Thus, Applicants’ claim 1, and dependent claims 2-10, expressly and unequivocally distinguish from the *Kraemer* and *Locarno* references. Accordingly, claims 1-10 are believed to be in condition for allowance.

This Amendment and these remarks are believed to be fully responsive to the Office Action mailed September 22, 2004, are believed to squarely address each and every ground for rejection or objection raised by the Examiner, and are further believed to materially advance

Appl. No. 10/665,539  
Amendment dated December 16, 2004  
Reply to Office Action of September 22, 2004

prosecution of this application toward immediate allowance.

Formal allowance of claims 1-10 is therefore courteously solicited.

Respectfully submitted,

PHILLIPS LYTTLE LLP

By



Michael J. Berchou

Reg. No. 48,233

3400 HSBC Center

Buffalo, New York 14203

Telephone: (716) 847-8400

Telecopier: (716) 852-6100

*Attorneys for Applicants*


Buffalo, New York  
Dated: December 16, 2004



CERTIFICATE OF MAILING

I certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop Non-Fee Amendments, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on December 16, 2004.


PHILLIPS LYTTLE LLP

By   
Michael J. Berchou, Esq.  
Reg. No. 48,233  
Signed: December 16, 2004

CERTIFICATE OF FACSIMILE TRANSMISSION

I certify that this correspondence is being forwarded transmitted by facsimile transmission to (703) 872-9306, on December 16, 2004.

PHILLIPS LYTTLE LLP

By   
Michael J. Berchou, Esq.  
Reg. No. 48,233  
Signed: December 16, 2004